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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,901	03/01/2004	Jeffrey C. Smith	127-0007-2	2607
22120 7590 03/29/2010 ZAGORIN O'BRIEN GRAHAM LLP 7600B NORTH CAPITAL OF TEXAS HIGHWAY SUITE 350 AUSTIN, TX 78731				
EXAMINER				
SCHMIDT, KARI L				
ART UNIT		PAPER NUMBER		
2439				
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03/29/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,901

Applicant(s)

SMITH ET AL.

Examiner

KARI L. SCHMIDT

Art Unit

2439

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

In view of the see Appeal Brief filed on 1/20/2010, PROSECUTION IS HEREBY REOPENED. The examiner notes new ground(s) of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Edan Orgad/

Supervisory Patent Examiner, Art Unit 2439.

Response to Arguments

Applicant's arguments, see Appeal Brief, filed 1/20/2010, with respect to the rejection(s) of claim(s) 1-33 and 36-41 under 35 U.S.C. 102/102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of McArdle et al. (UC 6,442,686 B1) in view of Dickinson et al. (WO 99/05814) and Flynn et al. (US 6,618,747).

Allowable Subject Matter

Claims 1-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the examiner notes the Specification does not provide antecedent basis for the claim terminology as recited in claims 1-29: "computer-readable medium." The examiner notes that one of ordinary skill in the art needs to utilize the specification in order to determine and interpret what "computer-readable medium" can be? The examiner notes a reasonable interpretation of the "computer-readable medium" can be a medium that can include a signal, thus causing the claim to be non-statutory.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, with the specification not defining "a computer readable medium" the claim as a whole can be drawn to a signal (see Specification Objection) and a signal doesn't fall within one of the four statutory categories of invention. Therefore a computer readable medium can be viewed as a signal or carrier wave. Further the examiner notes the claim may be amended by changing "computer readable medium" to "non-transitory computer readable medium" thus excluding that portion of the scope covering transitory signals. The scope of the disclosure given the state-of-the-art covers both transitory and non-transitory media and this amendment would limit the claim to an eligible (non-transitory) embodiment.

Claims 27-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, with the specification not defining "a computer readable media" (see Specification Objection) makes the claim as a whole be drawn to a software per se since "a computer readable media" viewed as a signal which does not fall within one of the four statutory categories of invention. Further the examiner notes the claim may be amended by changing "computer readable media" to "non-transitory

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computer readable memory medium" thus excluding that portion of the scope covering transitory signals. The scope of the disclosure given the state-of-the-art covers both transitory and non-transitory media and this amendment would limit the claim to an eligible (non-transitory) embodiment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 27-33 and 36-41 is rejected under 35 U.S.C. 103(a) as being unpatentable over McArdle et al. (UC 6,442,686 B1) in view of Dickinson et al. (WO 99/05814) and Flynn et al. (US 6,618,747).

Claim 27, 30, and 39-40

McArdle discloses a server interposed between a sender and one or more intended recipients of an electronically encoded information package, applying a ruled based policy associated with the sender's enterprise to the package and upon determination of a condition in which the policy permits delivery of the package (see at least, col. 3, lines 25-col. 4, lines 26: the examiner notes an agent (e.g. server) intercepts mail bound for the mail server and checks to make sure the mail conforms to a policy configured for a corporate site).

McArdle fails to disclose determining whether the policy permits delivery of the package to a particular one of the recipients; initiating notification of the particular recipient, wherein the notification include package identification data usable by the particular recipient to retrieve the electronically encoded information.

Dickinson discloses determining whether the policy permits delivery of the package to a particular one of the recipients (see at least, page 6, line 27-page 7, line 16: the examiner notes a recipient policy that can be enforced by the policy engine).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of McArdle to include determining whether the policy permits delivery of the package to a particular one of the recipients as taught by Dickinson. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide improved centralized control over e-mail messages exiting and entering an organization (see at least, page 2, lines 19-20).

McArdle in view of Dickinson fails to disclose initiating notification of the particular recipient, wherein the notification includes package identification data usable by the particular recipient to retrieve the electronically encoded information.

Flynn discloses initiating notification of the particular recipient, wherein the notification includes package identification data usable by the particular recipient to retrieve the electronically encoded information (see at least, abstract: the examiner notes the use of a unique address to point to location of the contents).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of McArdle in view of Dickinson to include initiating notification of the particular recipient, wherein the notification includes package identification data usable by the particular recipient to retrieve the electronically encoded information as taught by Flynn. One of ordinary skill in the art would have been motivated to combine the teachings in order to verify that the email and/or

attachment was received by the intended recipient (see at least, col 1, lines 61-col 2, line 1).

Claim 28-29, and 33

McArdle fails to disclose a hypertext transfer protocol (HTTP) type interface for sender interaction with at least one of the servers; and a simple mail transfer protocol (SMTP) type interface for supply of a notification message to the particular recipient.

Dickinson discloses a hypertext transfer protocol (HTTP) type interface for sender interaction with at least one of the servers (see at least, page 6, lines 11-18: the examiner notes HTTP). [Claim 29] Further Dickinson discloses wherein communications via at least one of the HTTP-type interface and the SMTP-type interface are secured using a secure socket layer (SSL) protocol (see at least, page 1, lines 20-30: the examiner notes the use of Secure Socket Technologies for the WWW and page 6, lines 11-18: the examiner notes HTTP and the use of SMTP module to reply messages and page 7, lines 11-16: the examiner notes notifications are sent as messages).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of McArdle to a hypertext transfer protocol (HTTP) type interface for sender interaction with at least one of the servers as taught by Dickinson. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide improved centralized control over e-mail messages exiting and entering an organization (see at least, page 2, lines 19-20).

McArdle in view of Dickinson fails to disclose a simple mail transfer protocol (SMTP) type interface for supply of a notification message to the particular recipient.

Flynn discloses a simple mail transfer protocol (SMTP) type interface for supply of a notification message to the particular recipient (see at least, col. 4, lines 51-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of McArdle in view of Dickinson to include a simple mail transfer protocol (SMTP) type interface for supply of a notification message to the particular recipient as taught by Flynn. One of ordinary skill in the art would have been motivated to combine the teachings in order to verify that the email and/or attachment was received by the intended recipient (see at least, col 1, lines 61-col 2, line 1).

Claim 31

McArdle discloses an interface for communication with a policy authority for the sender's enterprise (see at least, col. 8, lines 66-col. 9, line 1).

Claim 32

McArdle discloses a policy Authority (see at least, col. 8, lines 66-col. 9, line 1: the examiner notes an Agent).

Claims 36-38

McArdle discloses wherein the particular recipient is not associated with the sender enterprise (see at least, col. 3, lines 25-col. 4, lines 26).

Claims 41

McArdle in view of Dickinson fails to disclose wherein the interposed server is not within the sender's enterprise (see at least, col. 3, lines 25-col. 4, lines 26).

Flynn discloses wherein the interposed server is not within the sender's enterprise (see at least, col. 4, lines 51-56: the examiner notes a web based e-mail client).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of McArdle in view of Dickinson to include wherein the interposed server is not within the sender's enterprise as taught by Flynn. One of ordinary skill in the art would have been motivated to combine the teachings in order to verify that the email and/or attachment was received by the intended recipient (see at least, col. 1, lines 61-col. 2, line 1).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARI L. SCHMIDT whose telephone number is (571) 270-1385. The examiner can normally be reached on Monday - Friday: 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on 571-272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kari L Schmidt/
Examiner, Art Unit 2439

/Edan Orgad/
Supervisory Patent Examiner, Art Unit 2439